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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/764,937      | 01/26/2004  | George R. Kaplan     | LKI 205.4           | 9317             |

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EXAMINER

EVANS, GEOFFREY S

ART UNIT PAPER NUMBER

1725

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/764,937

Applicant(s)

KAPLAN ET AL.

Examiner

Geoffrey S. Evans

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 126-149, 151-166, 168-172, 174-176 and 202-204 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-149, 151-166, 168-172, 174-176, and 202-204 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 126-149, 151-166, 168-172, 174-176 and 202-204 are rejected under 35 U.S.C. 135 (b) as being made more than one year from the date on which Kerner in U.S. 2002/0030039 was published under 35 U.S.C. 122 (b). See *In re McGrew*, 120 F. 3d 1236, 1238 43 USPQ 2d 1632, 1635 (Fed. Cir. 1997) where the court held that the application of 35 U.S.C. 135 (b) is not limited to inter partes interference proceedings, but may be used as a basis for ex parte rejections.
2. While this application copied claims within one year of the publication of US Patent No. 6,552,300, Applicant did not copy claims from the pre-grant publication 2002/0030039 (pub date 3/14/02) within one year as required by 35 USC 135(b)(2). Please note that the specification of Kerner in US 2002/0030039 makes clear that mapping system includes "imaging and imaging processing means" (see paragraph 14) and therefore is an "electronic imager". See MPEP 2304.02(c). This analysis is also applicable to new claims 202-204.
3. Applicant's arguments filed 27 September 2006 have been fully considered but they are not persuasive. Please note comments by Applicant's representative Steven Hoffberg in the response of 10 September 2004 " ... This is especially true where Groups I and II are copied from the very same patent, and thus were previously categorized by the USPTO as being the same invention. There is no explanation for the different treatment in the present application for the very same claims as presented together in US. 6,552,300." It is clear from the word "copied" in the first sentence of this quote that claims were knowingly copied from U.S. Patent No. 6,552,300. Group I was

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listed as claims 126-138, 150-164 and Group II corresponds to claims 139-145 and 165-176 in the restriction of 11 August 2004. Since Applicant has argued that the claims of Group I and Group II to be of the same invention all claims in these two groups should stand or fall together. Applicant secondly argues that support exists for these claims in earlier applications. No support is found in the claims found in the earlier applications (01/237,329, 09/688,655, 09/302,982, and 08/690,309) by applicant of these claims as argued on page 13 of the Remarks. Claims 177-201 are currently cancelled so Applicant's remarks regarding these claims are not relevant to this application.

4. Please note that independent claim 154 is currently identical in scope to dependent claim 5 of U.S. Patent Application Publication No. 2002/0030039 (which includes all of the limitations of claim 1 of U.S. Patent Application Publication No. 2002/0030039).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

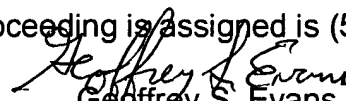
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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey S Evans whose telephone number is (571)-272-1174. The examiner can normally be reached on Mon-Fri 6:30AM to 4:00 PM, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on (571)-272-1292. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

GSE

  
Geoffrey S. Evans  
Primary Examiner  
Group 1700